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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,230	08/08/2001	Ruth E. Rosenholtz	110269	9875

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EXAMINER	
ZHOU, TING	
ART UNIT	**PAPER NUMBER**
2173	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/682,230	ROSENHOLTZ ET AL.	
	Examiner	Art Unit	
	Ting Zhou	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,12-19,26 and 27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,2,12,13 and 26* is/are allowed.

6)☒ Claim(s) *3-8,14-19 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *26 October 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 31 January 2005 under 37 CFR 1.53(d) based on parent Application No. 09/682,230 is acceptable and a RCE has been established. An action on the RCE follows.

2. The amendments filed on 31 January 2005, submitted with the filing of the RCE have been received and entered. The applicants have cancelled claims 9-11, 20-22 and 28. Claims 1-8, 12-19 and 26-27 as amended are pending in the application.

3. During a telephone conversation with Mr. Kentaro Higuchi on 23 April 2005, the examiner suggested that the applicant should amend the specification to replace the Attorney Docket Nos. for co-pending non-provisional applications by the same inventor, listed on page 1 of the specification, with the corresponding U.S. application numbers in the next response.

Allowable Subject Matter

4. Claims 1-2, 12-13 and 26 are allowed.

5. The following is an examiner's statement of reasons for allowance: The present invention teaches a method of displaying a document via selection of a portion of a thumbnail. Each of independent claims 1, 12 and 26 identifies the distinct feature of displaying a thumbnail having at least one first selectable element and a second, separate selectable portion, the second portion of the thumbnail being selectable and having an original document as a first associated

destination, and the at least one first selectable element having, as a second associated destination, one of (a) a portion of the original document, smaller than the original document as a whole and (b) a document other than the original document. The closest prior art, Hahn et al. U.S. Patent 5,751,287 teach a thumbnail with a selectable portion with a destination of an original document in one embodiment and a thumbnail with a selectable portion with a destination of a portion of the original document in another embodiment. The prior art fails to teach one thumbnail having two selectable portions with two associated destinations and thus fails to anticipate or render the above limitations obvious.

6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3-8, 14-19 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "the arbitrary portion not being positionally corresponding to the second selectable element", on lines 3-4, 6-7, 3-4, 8-9 and 7-8 of claims 3, 4, 14, 15 and 27 respectively, is not positively recited in the specification of the present application. The disclosure does not explicitly recite the exclusion of the arbitrary portion from being positionally corresponding to the second selectable element. Therefore, there is no positively recited basis for the negative limitation of "the arbitrary portion not being positionally corresponding to the second selectable element".

8. In a conversation with Mr. Steve Catlin and Mr. Kentaro Higuchi, the examiner confirmed that the limitation "the arbitrary portion not being positionally corresponding to the second selectable element" was intended to be "the arbitrary portion being positionally corresponding to the second selectable element". In the interest of fully examining the presented claims and expediting prosecution, for prosecution purposes, the examiner will treat the limitation "the arbitrary portion not being positionally corresponding to the second selectable element" in claims 3-4, 14-15 and 27 as "the arbitrary portion being positionally corresponding to the second selectable element". However, a formal amendment with the corresponding changes to claims 3-4, 14-15 and 27 is required in response to this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 4, 7-8, 15, 18-19 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn et al. U.S. Patent 5,751,287.

Referring to claims 4, 15 and 27, Hahn et al. teach a method, system and information storage medium for displaying a document comprising a display device and controller (computer system including display screen and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that displays a thumbnail associated with an original document (display of thumbnail views of pages in a document) (column 11, lines 46-52 and Figure 16) and having at least one first selectable element, each of at least one first selectable element having, as an associated destination, one of (a) an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document and (b) a document other than the original document (the thumbnail has a selectable element, i.e. the thumbnail as a whole can be selected and a region of the page of the document can be displayed, as shown in Figure 16; however, the region of the page of the document can also be accessed, i.e. displayed, via selection of a selectable element in the page of the document, i.e. the user can directly select a portion of the thumbnail page and in response, the selected portion of the page is displayed) (column 11, lines 48-56, column 12, lines 24-28 and Figure 16), the arbitrary portion being positionally corresponding to the second selectable element (the portion displayed corresponds to the selected portion of the thumbnail page) (column 12, lines 24-28); receiving a selection of one of the at least one first selectable element and directly accessing the associated destination based on the selection without first accessing the original document (receiving user input selecting the thumbnail itself

and directly displaying a portion of the page in response) (column 11, lines 48-56 and Figure 16), wherein the thumbnail is a reduced-size representation of at least a part of the original document (thumbnail region 1710 in Figure 16 which gives a "thumbnail" view of the pages in the original document; in addition, it is noted that the definition of thumbnail according to http://www.webopedia is a "miniature display of a page to be printed", which a reduced sized representation o the page) (column 11, lines 41-56).

Referring to claims 7 and 18, Hahn et al. teach the document other than the original document being accessible by selection of a third selectable element provided in the original document (any other page in the document can be selected by the user) (column 12, lines 12-40).

Referring to claims 8 and 19, Hahn et al. teach the at least one first selectable element being a visibly discrete element, as shown by the separately selectable thumbnails in display area 1170 in Figure 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 5-6 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. U.S. Patent 5,751,287, as applied to claims 4 and 15 above, and Brown et al. U.S. Patent 6,405,192.

Referring to claims 5 and 16, Hahn et al. teach all of the limitations as applied to claims 4 and 15 above. However, Hahn et al. fail to explicitly teach the thumbnail being an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67 and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document (modifying the appearances of the thumbnails by placing a dark border around the thumbnails that contain matches to the user's undesirable criteria, adding a "Do Not Enter" icon indicating to the user that the linked page contains undesirable features or displaying the thumbnail with different colors, etc.) (Brown et al.: column 10, lines 2-25 and further shown in Figures 9-11). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users' interests.

Referring to claims 6 and 17, Hahn et al. teach all of the limitations as applied to claims 4 and 15 above. However, Hahn et al. fail to explicitly teach the element with the modified appearance is the first selectable element. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67 and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach the element with the modified appearance is the first selectable element (the thumbnail, with a modified appearance is a link to a page from the search results that the user can select from) (Brown et al.: column 9, lines 64-67 through column 10, lines 1-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users' interests.

Response to Arguments

11. Applicant's arguments, see pages 7-9, filed 31 January 2005, with respect to claims 1-3, 12-14 and 26 have been fully considered and are persuasive. The rejection of claims 1-3, 12-14 and 26 has been withdrawn.

12. Applicant's arguments filed 31 January 2005, with respect to claims 4-8, 15-19 and 27 have been fully considered but they are not persuasive:

13. The applicant asserts that the examiner's statement of "However, even if the user has to retrieve the selectable elements in the original document by selecting the corresponding section in the thumbnail first and then selecting the selectable element in the original document to access the arbitrary position..." is an admission that Hahn does not teach or suggest directly accessing the associated destination (i.e. without first accessing the original document). The examiner respectfully disagrees. The examiner's statement was merely a rebuttal of the applicant's argument that the user has to retrieve the selectable elements in the original document by selecting the corresponding section in the thumbnail first and then select the selectable element in the original document to access the arbitrary, and therefore, an arbitrary destination is not associated with the selectable element, made on page 4 of the response filed on 20 August 2004; the examiner's reply does not state that the applicant's arguments about the user having to retrieve the selectable elements in the original document by selecting the corresponding section in the thumbnail first are true, but merely states that even **if** what the applicant asserted about the user having to retrieve the selectable elements in the original document by selecting the corresponding section in the thumbnail first were true, an arbitrary destination is still associated with the selectable element of the thumbnail.

14. Having clarified the above misunderstanding, the examiner respectfully disagrees with applicant's assertion that the position in Hahn does not correspond to the claimed arbitrary position as defined and that claim 4 is patentably distinct from Hahn. Hahn teaches that an arbitrary portion of the original document can be displayed via the selection of a first selectable

element in the thumbnail and a selectable element of an original document; Hahn teaches that upon selection of a thumbnail 1730, the corresponding page is displayed in view region 1720 of Figure 16; as shown in Figure 16, only a portion of the page corresponding to the selected thumbnail is displayed; therefore, an arbitrary portion of the page corresponding to the selected thumbnail, i.e. an arbitrary portion of the original document, is displayed (column 11, lines 48-56 and Figure 16); Hahn further teaches that an arbitrary portion, i.e. a portion of the thumbnail page can also be accessed by selection of a selectable element provided in the page, as recited in column 12, lines 24-27, which teaches that uses can directly select a portion of the thumbnail page, i.e. a selectable element of the page and in response, the corresponding selected portion of the page is displayed. Therefore, the examiner respectfully maintains that Hahn teaches the limitations of claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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